

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN THE APPLICATION OF:

Randall Allen Vogel et al

CASE NO.: AD6728USNA

SERIAL NO.: 09/833,452

GROUP ART UNIT: 1794

FILED: 04/12/2001

EXAMINER: Monique R. Jackson

FOR: Multilayer, Co-Extruded, Ionomeric Decorative Surfacing

APPELLANTS' REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The examiner's Answer mailed 04/02/2008 raises new issues that were not in the previous Office actions. Appellants therefore submit this reply brief to address such issues. The following page numbers refer to the page numbers in the Answer.

1. Page 7, last line to page 8, the end of first full paragraph. The examiner appears to argue that if a base claim reciting limitation A is not rejected, a dependent claims reciting extra limitations A + B can be rejected. Appellants disagree.

Along the same subject, the examiner asserts (page 9, first full sentence, *et seq.*) that, because appellants' application discloses Class A surface typically has a DOI of at least 60, preferably 80 or higher, reference Smith must have disclosed a DOI of at least 80. It does not appear logic to appellants.

As the examiner noted, the key is the term "Class A" surface. Smith does not disclose the film disclosed therein has a Class A surface. Smith does disclose on column 14, line 57 to column 15, line 34, as follows.

An exemplar material which may be used as color pigmented layer . . . is Millennium IIITM, . . . GE LexanTM layers on top and bottom (ABA tri-manifold coextrusion). Millennium III is available from Spartech Alloy Plastics, and is a composite product of 20% (preferably from about 10-30%) glass-filled **polycarbonate** that provides the physical properties of glass-filled polycarbonate with a "Class A" finish of a standard **polycarbonate** sheet.

Smith appears to disclose a *polycarbonate* (where appellants highlighted), not the ionomer/ionomer film disclosed and recited in appellants' application. Therefore,

the “Class A” surface in appellants’ application is not the same as the “Class A” surface of Smith.

The minimum 60 with maximum 100 argument employed in the Answer purports to suggest that Smith teaches such product. However, as disclosed in column 19, lines 58-69, Smith discloses as follows.

Distinctiveness of image (DOI) is a measurement of the clarity of an image reflected by the finished surface. Each of these products/parts *may* have a DOI of at least about 60 units, where 100 is the maximum DOI *reading*, ***measured by a Hunter Lab, Model No. D47R-6F Dorigon gloss meter.*** Details of this DOI test procedure are described in GM test specification GM-204-M which is incorporated herein by reference.

Smith merely discloses that the DOI *measured by the instrument (the gloss meter)* may have reading of at least 60 and maximum 100. This disclosure cannot be translated into disclosing at least 80 as the Answer suggests.

2. Page 9, end of the first paragraph. The examiner is questioning whether the specification provides sufficient guidance to produce the film having the claimed DOI. Appellants’ application discloses how a thermoformed surface can be made high DOI. For example, appellants’ application discloses in the paragraph bridging pages 5 and 6 that . . . with Class A surface by using backfill materials with the thermoformable surface sheet.

On the same page (last line) of the Answer, the examiner questions appellants’ arguments with respect to “no pigment”.

Claims 70-72 directly or indirectly depend from claim 6, which recites that the first co-extruded polymeric layer is *clear* and the second co-extruded polymeric layer comprises . . . pigment, dye, flake, or mixtures thereof. Claims 70-72 must have the same limitations as claim 6. Appellants agree to the examiner assertion about the first additive and second additive, but the recitation in claim 1 does not mean that the first layer must contain pigment and the one limitation recited in claim 6 is that the first layer must be clear (no pigment). Please note that appellants’ recitation of additive in claim 1 is “or” meaning that each layer requires only one or more of the recited additives and does not mean that pigment must be present in the first layer.

3. Page 13, first paragraph. The examiner argues that appellants’ recitation of thermoformable film or sheet is intended use. Appellants submit that the examiner

may have overlooked appellants' claim 1. In claims 1 the recitation of the film or sheet is a thermoformable film or sheet is in the body of the claim, not in the preamble as the Answer attempts to portrait. That is, the recitation of thermoformable film or sheet is claim limitation, not intended use as alleged in Answer.

The examiner then argues that the JP'828 film is *capable* of being thermoformed (*italics* original). Appellants are not sure how such conclusion is made and, even if the conclusion were true, a film *capable* of being thermoformed is not the same as a thermoformable film because *capable* of being thermoformed still needs to be processed to become a thermoformable film.

4. Page 15, last paragraph. The Answer for the first time states that 5 mils disclosed in Flieger is close enough to 8 mils. Appellants submit that this argument stretches too far because (1) 8 mils is $((8-5)/5 = 0.6)$ 60% thicker than 5 mils and (2) appellants' appeal brief details how Flieger prejudices against any thicker film. Appellants would agree to the Answer if appellants' claim were about 10% thicker.

Respectfully submitted,

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